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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/895,950	07/17/1997	ANDREAS WINTER	HOE-90/F-333	1558

23416 7590 10/20/2003

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EXAMINER

TESKIN, FRED M

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/895,950

Applicant(s)
Winter, et al.

Examiner
Fred Teskin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 2, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 19-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152) _____
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 29 6) ☐ Other: _____

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1. Acknowledgement is made of the Response of December 2, 2002, including a fourth supplemental reissue declaration.

2. The rejection under 35 U.S.C. 251 as set out in section 4 of the previous Office action (paper no. 28) is **withdrawn** in view of the copy of the Decision submitted by facsimile transmission on June 27, 2003, evidencing acceptance of late payment of the second maintenance fee for US Patent 5,276,208 and reinstatement of said patent as of April 3, 2003.

3. The Assent of Assignee filed April 3, 2002 is not proper because, while the assignee has established ownership by citation of reel and frame number, the submission fails to set forth the authority of the persons signing the assent to act on behalf of the assignee. See MPEP 324(B).

4. This application stands objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

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5. Applicants' arguments filed December 2, 2002 have been fully considered but are not persuasive of error in the repeated objection.

Applicants point to an English translation of a company name change submitted with the Response as evidence that Dr. Meyer and Dr. Seelert have the authority to sign on behalf of the company.

Examiner disagrees. The submitted evidence merely identifies Drs. Meyer and Seelert, among others, as general authorized signatories. This is not an empowerment statement of the type provided for in MPEP 324(C), e.g., empowerment by a corporate resolution; nor is it clear from their titles that Dr. Meyer and Dr. Seelert are officers of the company. Accordingly, the objection is still deemed to be tenable and is therefore maintained.

6. The reissue declaration filed with this application and the four supplemental reissue declarations are defective because the errors sought to be corrected are not proper. The original declaration is actually a copy of the reissue declaration filed in the first reissue (application no. 08/324,260, Re 37,208). Since that reissue corrected the errors identified in the original declaration, those errors are not a proper basis for the instant reissue application. None of the subsequently filed supplemental

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declarations define an error; i.e., the statement that "the claims were amended because of prior art that I was not aware of and 35 USC 112 rejections ...," contained in each of the supplemental declarations, does not identify an error correctable by reissue.

7. Applicants' arguments filed December 2, 2002 have been fully considered but are not persuasive of error in the repeated rejection.

Applicants believe that in view of combining all four declarations, this rejection should be withdrawn.

Examiner disagrees, as none of the declarations identifies a specific error correctable by reissue. The original reissue declaration, as noted above, is a copy of the reissue declaration filed in the first reissue (application no. 08/324,260). Applicants urge that the original reissue declaration is proper because this application contains the original broadened filed reissue claims (claims 1-15).

While this application does indeed contain such original reissue claims, the question remains as to what error was corrected in the original reissue. There must have been another error; if not, there is a presumption that the errors identified in the original reissue declaration were rectified by the first reissue.

Accordingly, applicants are called upon to explain what error

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is relied upon to support the present reissue application which was not rectified by the first reissue application. The explanation should identify such error by reference to the specific claim(s) and the specific claim language wherein lies the error. (See MPEP 1414, under section II.)

None of the supplemental declarations of record identify an error in the claims by reference to specific claim language; i.e., language describing subject matter which applicants were entitled to claim but failed to claim due to error made without deceptive intent. Accordingly, even when considered collectively, the declarations fail to identify a specific error correctable by reissue.

8. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 C.F.R. §§ 1.121(h) and 1.173(b)-(g).

9. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

FMTeskin/05-14-03


FRED TESKIN
PRIMARY EXAMINER
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